

00 18:02

AF1/600
#21 F
PS

CASE 4-30879/A/CGC 2114 NE



FILING BY "EXPRESS MAIL" UNDER 37 CFR 1.10

EL 820014425 US
Express Mail Label Number

July 16, 2002
Date of Deposit

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

Art Unit: 1624

PAIVI JAANA KUKKOLA

Examiner: T. Truong

APPLICATION NO: 09/533,219

FILED: MARCH 23, 2000

FOR: THYROMIMETIC ORGANIC COMPOUNDS

Assistant Commissioner for Patents
Washington, D.C. 20231

RECEIVED
TECH CENTER 1600/2900
JUL 23 2002

RESPONSE AFTER FINAL REJECTION

Sir:

This is in response to the Office action of May 16, 2002 on the above identified Application No. 09/533,219.

The claims under consideration are claims 9, 11, 14, 16-19 and 21-25.

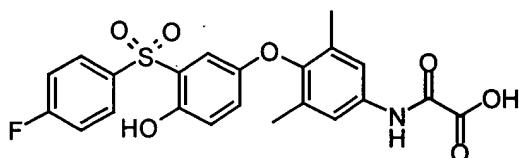
The applicant respectfully requests reconsideration of the rejection of claims 9, 11, 14, 16-19 and 21-25 under 35 U.S.C §102(e) as being anticipated by Chiang et al. (U.S. Patent No. 6,326,398).

The instant application claims the benefit of U.S. provisional application No. 60/183,030 filed on March 29, 1999 (which was converted from non-provisional application No. 09/250,105).

Chiang et al. U.S. Patent No. 6,326,398 claims the benefit of U.S. provisional application No. 60/122,292 filed on March 1, 1999.

Both priority applications are of record in the instant application. A copy of a certified copy of application No. 60/122,292 was made of record with Information Disclosure Statement filed October 25, 2000. A certified copy of provisional application No. 60/183,030 was submitted with communication filed November 14, 2000.

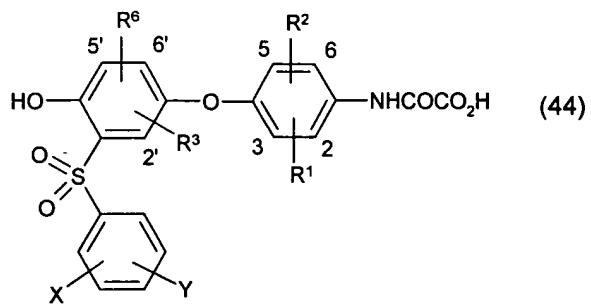
As stated in the response to the previous office action, the broadest compound claim of the instant invention, claim 9, claims a single compound, pharmaceutically acceptable salts thereof and pharmaceutically acceptable prodrug esters thereof. The compound as such, i.e., N-[4[3-(4-fluorobenzenesulfonyl)-4-hydroxyphenoxy]-3,5-dimethyl-phenyl]oxamic acid, is claimed in the instant claim 22, and its structure as given in Example 26 on page 31 of the instant application is



Regarding the instant claims, it is respectfully submitted that the subject matter claimed in the instant claims 9, 11, 14, 16-19 and 21-25 is fully supported by the parent provisional application No. 60/183,030 filed on March 29, 1999. For example, Example 25 on page 31 of the parent application is directed to the compound of the instant claim 22 and corresponds to Example 26 of the instant application. Furthermore, the instant claim 9 corresponds to the original claim 8 of the priority application.

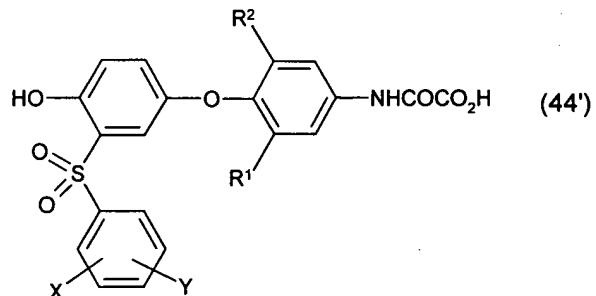
Chiang et al. U.S. Patent No. 6,326,398 which issued on December 4, 2001 and was filed on February 28, 2000, indeed names the compound of the instant claim 22 on column 10, lines 50 and 51. However, no such disclosure appears in priority provisional application No. 60/122,292 filed March 1, 1999.

The subgenus of oxamic acids represented by formula 44 on page 37 of the Chiang et al. priority application shown below



encompasses a vast number and perhaps even indefinite number of compounds with a variety of possible substituents and regioisomers. For example, R¹, R² and R³ may be independently hydrogen, halogen, C₁₋₆ alkyl, trifluoromethyl, -CN or -OCF₃ (as defined on page 3, lines 18 and 19 of Chiang et al.); R⁶ may be hydrogen, halogen, C₁₋₄ alkyl or trifluoromethyl (as defined on page 4, line 2 of Chiang et al.); and X and Y may be independently hydrogen, halogen, trifluoromethyl, -OCF₃, -CN, C₁₋₆ alkyl optionally substituted with one or more substituents independently selected from the group consisting of halogen, -OCF₃, -CF₃ and phenyl; or X and Y may be C₁₋₆ alkoxy, aryl optionally substituted with one or more substituents selected from etc. (as defined starting on page 5, line 26 of Chiang et al.). In addition, as illustrated by formula 44 of Chiang et al. priority application, R¹ and R² may be independently located at the 2, 3, 5 or 6 position, R³ and R⁶ may be independently located at the 2', 5' or 6' position, and X and Y may be independently located at any free position of the phenyl group to which they are attached.

Chiang et al. priority application discloses on page 6 preferred compounds of formula I, designated as the A, B, C and D group. Limitations set forth by the A, B, C and D groups combined with the subgenus represented by formula 44 encompass oxamic acids of the narrowed scope as illustrated below with formula 44'



wherein R¹ and R² are independently methyl, bromo or chloro; and X and Y have broad meanings as defined above for formula 44.

Although limitations set forth by the preferred groups A, B, C and D narrow the scope of the subgenus of formula 44, the resulting subscope, as represented by formula 44' above, still encompasses a vast number of oxamic acid derivatives. Therefore, in accordance with MPEP 2131.02 (page 2100-71, second paragraph) the specific compounds of the instant claim 9, i.e. a single novel oxamic acid of the instant claim 22 along with pharmaceutically acceptable salts thereof and pharmaceutically acceptable prodrug esters thereof, are not anticipated by the broad scope of compounds encompassed by formula 44 of the Chiang et al. priority application, filed March 1, 1999.

Furthermore, in the Chiang et al. priority application the most preferred groups of compounds of formula I wherein R⁴ is -S(O)₂R¹² do not even embrace the compound of the instant claim 22 (please see third and fourth paragraphs on page 10 of the Chiang et al. priority application). Thus, the broad scope of compounds of formula 44 with further limitations set forth by the preferred groups A, B, C and D, i.e. compounds of formula 44', represent the narrowest scope in the Chiang et al. priority application relevant to the claims of the instant application.

In view of the above, it is respectfully submitted that regarding the instant claims 9, 11, 14, 16-19 and 21-25, Chiang et al. U.S. Patent No. 6,326,398 cannot be effective as a prior art reference for anticipation under 35 U.S.C §102(e) as of the filing date of its priority application, March 1, 1999.

In contrast thereto, the priority application of the instant application fully supports the instant claims 9, 11, 14, 16-19 and 21-25, and its filing date, March 29, 1999, is prior to the February 28, 2000 filing date of U.S. Patent No. 6,326,398.

Therefore, it is respectfully submitted that the rejection of the instant claims 9, 11, 14, 16-19 and 21-25 under 35 U.S.C §102(e) as being anticipated by U.S. Patent No. 6,326,398 is overcome by the priority application of the instant application, filed March 29, 1999.

In further support of the patentability of the subject matter of the instant claims over Chiang et al. U.S. Patent No. 6,326,398, the applicant is enclosing herewith a Declaration under 37 C.F.R. § 1.131 showing actual reduction to practice of the invention of the instant claims prior to March 1, 1999, the filing date of Chiang et al. provisional priority application No. 60/122,292.

Reconsideration of the provisional non-statutory double patenting rejections over co-pending Applications No. 09/696,502 and No. 09/702,634 is respectfully solicited.

Provided that the instant claims are now allowable, and since the co-pending applications No. 09/696,502 and No. 09/702,634 have not yet been allowed, the Examiner is respectfully requested to withdraw both the provisional rejections and permit the instant application to issue as a patent in accordance with MPEP 804 (paragraph B on page 800-19).

It is respectfully submitted that all the instant claims are in condition for allowance and such is earnestly solicited.

Respectfully submitted,

Novartis Corporation
Patent and Trademark Dept.
564 Morris Avenue
Summit, NJ 07901-1027

Norbert Gruenfeld

Norbert Gruenfeld
Agent for Applicant
Reg. No. 30,061
(908) 522-6926

Encl.: Declaration under 37 C.F.R. § 1.131

Date: July 16, 2002